

Attorney's Docket: 2001DE307/D
Serial No.: 10/677,412
Art Unit 1625
Response to Office Action, Mailed 03/25/2005

REMARKS/ARGUMENTS

The Office Action mailed May 25, 2005 has been carefully considered. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks and amendments is respectfully requested.

Applicant would like to thank the Examiner to discuss the formal issues of the application in a telephonic interview with Applicant's representative, Mr. Silverman, on August 9, 2005. In the interview, Applicant pointed out that the radical $C_{aryl,alkyl}$ is a name for the position shown in the formula (II), and therefore should not be limited to being a carbon atom joined to the ring structure. Applicant's intent for the broader definition of this radical $C_{aryl,alkyl}$ is more clearly shown in claim 2 wherein the radical $C_{aryl,alkyl}$ is equivalent to many different substituents which include both carbon atoms and non-carbon atoms. Applicant's invention relates to a novel method of forming substituted aromatic compounds by reacting chlorinated or fluorinated compounds of formula (I) in the presence of lithium and a C-electrophile, such as those listed in the Markush group of claim 2. Following the reaction, the compounds of formula (II) are produced with the identified radical $C_{aryl,alkyl}$ in the position shown in formula (II). Thus, the elements of the Markush group in claim 2 share a common utility and a substantial structural feature essential to that utility. Applicant agreed to limit the elements X^{1-5} of claim 1 as "each carbon with at least one X^{1-5} being nitrogen" to comply with the Examiner's suggestion. As the Examiner indicated, this action would

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overcome the rejection of claim 2 for being an improper Markush group. Applicant agreed to cancel claim 8.

Applicant has amended the Application to attend to housekeeping matters and to more clearly describe the invention. Claim 1 was amended to recite that the symbols X^{1-6} are each carbon with at least one X^{1-6} being nitrogen. Claim 1 was also amended to recite that R is an alkyl having 1 to 5 carbon atoms. Support for this amendment may be found in originally filed claim 1 and in Example 19. Claim 2 was amended to correct a typographical errors which was not earlier noticed to properly refer to R¹ in the azomethines term and the amides term and to replace the "Met" with "CH₃" in the acetates form of the alkali metal and alkaline earth metal salts term. Also, in claim 2, the R radical in the ketenes term was recited to be an alkyl having from 1 to 5 carbon atoms. Support for the amendments to claim 2 may be found in originally filed claims 2 and claim 1. It is believed that no new matter is introduced by this amendment, and that no additional search is required by the office.

Claims 1-20 were rejected on the grounds that the claims were drawn to an improper Markush group. The objection of claims 1-20 on the grounds that they are drawn to an improper Markush group should be withdrawn in view of the above amendments which more clearly show that the Markush claims do not lack unity of invention because they share a common utility and a substantial structural feature in the which is essential to the process of Applicant's invention wherein the C-electrophile group is substituted on to the ring structure in the position labeled C_{arylealkyl} in formula(II).

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Claims 1 and 2 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As discussed hereinabove, in claim 1, the radical C_{aryl-alkyl} is a name for the position shown in the formula (II), and therefore should not be limited to being a carbon atom joined to the ring structure. In claims 1 and 2, all occurrences of R are now more clearly represented as an alkyl group having from 1 to 5 carbon atoms. Therefore, the rejection of claim 1 and 2 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention should be withdrawn in view of the above amendments and remarks.

Claims 3-7 and 9-20 were objected to as being dependent upon a rejected base claim. The objection to claims 3-7 and 9-20 as being dependent upon a rejected base claim should be withdrawn in view of the above amendments and remarks.

Claims 1-7 and 9-20 are pending in the application and these claims were subject to a restriction and/or an election requirement to proceed with the prosecution on the merits. For the purpose advancing the case, Applicant had elected the single species disclosed in Applicant's Example 19 of Applicant's Specification. In example 19, 3-acetylpyridine is prepared from 3-chloropyridine. This pyridine compound readable on by independent claim 1 and dependent claims 2-7 and 9-20. Applicant appreciates the difficulty of searching the invention with so many possible core structures, and notes the Examiner's efforts to search the pyridine core structure as a species. In view of the Examiner not finding relevant art to the

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elected pyridine species, Applicant requests the Examiner to group the 6-member ring pyridine species and the similar 5-member ring structures, wherein the 5-member ring structures, are also limited to containing at least one X^{1-5} being nitrogen and X^1R^1 and X^2R^2 are the same and are O, S, or a substituted N compound.

It is respectfully submitted that, in view of the above remarks the rejections under 35 U.S.C. 112, and the objections to the claims should be withdrawn and that this application is in a condition for an allowance of all pending claims. Accordingly, favorable reconsideration and an allowance of all pending claims are courteously solicited.

An early and favorable action is courteously solicited.

Respectfully submitted,



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